REMARKS/ARGUMENT

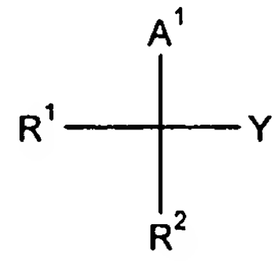
Claims 9 through 19 are pending in the application. Claims 9 through 18 are amended. Claim 18 is withdrawn from consideration. Claims 1 through 8 are canceled, and new claim 19 is added. No fee is required.

Initially, the Examiner's attention is directed to co-pending U.S. Patent Application Serial No. 10/588,534, which claims similar, but patentably distinct, subject matter.

Claims 1, 2, and 4 through 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over WO 2001/11965 (Cooke et al.) in view of WO 2002/069712 (Holah et al.), and further in view of Colby, 15 WEEDS 202-22 (1967).

For convenience, in responding to this Office Action, the Applicants refer to the U.S. equivalents of the two PCT publications, U.S. Patent No. 6,821,992 to Cooke et al. and U.S. Publication No. 2007/0293549 to Holah et al.

Cooke et al. disclose compounds of general formula I,



where A^1, R^1, R^2, and Y are as defined in the description and to their use as phytopathogenic fungicides.

It has been pointed out in the second paragraph of the present specification that international patent application WO 01/11965 generically discloses numerous

pyridylethylbenzamide derivatives. The specification also points out that the possibility of combining one or more of these numerous pyridylethylbenzamide derivatives with known fungicidal products to develop a fungicidal activity is disclosed in general terms without any specific example or biological data.

It is submitted that there is no teaching or suggestion in Cooke et al. of the synergistic effect obtained when these pyridylethylbenzamide derivatives are combined with compounds capable of inhibiting the spores germination or mycelium growth by acting on different metabolic routes.

In the Office Action the Examiner makes repeated statements that seem to imply that N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide is specifically disclosed in Cooke et al. The disclosure of the reference has been carefully reviewed, and such a specific teaching has not been found. The Applicants do not deny that the broad disclosure of Cooke et al. reads on N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide but do not believe this compound, per se, is mentioned. If the Applicants are in error, the Examiner is respectfully requested to point out where in the reference this compound, per se, is disclosed.

The Examiner acknowledges that Cooke et al. do not specifically teach:

that the N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide compound is combined with the additional agent in a weight ratio range from 0.01 to 20;

that N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide can be combined with a dicarboxamide derivative in a fungicidal composition;

that the dicarboxamide derivative in the composition is chlozolinate, iprodione, procymidone, or vinclozolin;

that N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide can be combined with a phthalimide derivative;

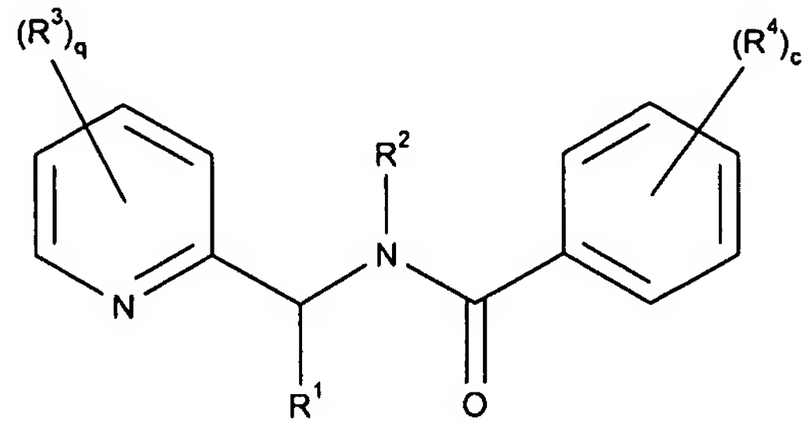
that N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide can be combined with a phthalimide derivative such as captan;

that N-{2-[3-chloro-5-(trifluoromethyl)-2-pyridinyl]ethyl}-2-trifluoromethylbenzamide can be combined with a compound capable of inhibiting fungal spore germination or mycelium growth, such as cymoxanil; or

that an additional compound (c) selected from diethofencarb, hexaconazole, cyprodinil, tebuconazole, or bromuconazole can be employed.

The secondary references, Holah et al. and Colby, fail to supplement these deficiencies of Cooke et al.

Holah et al. disclose a compound of the formula:



where R^1 can be hydrogen. Thus, in one embodiment, the Holah compound can have a $-CH_2-$ group between the pyridine ring and the benzamide moiety. However, the compounds employed in the practice of the present invention have a $-CH_2-CH_2-$ moiety between the pyridine ring and the benzamide moiety. Accordingly, Holah does not teach the use of the compounds employed in the practice of the present invention. Further, to the best of the current Applicants' understanding, the Holah et al. compounds do not fall within the scope of the teaching of Cooke et al. either, since it does not appear that Cooke et al. disclose compounds having a $-CH_2-$ (methylene) group between the pyridine ring and the benzamide moiety. Thus, it is submitted that the Holah et al. teaching is not properly combinable with Cooke et al. to render the present invention obvious to those of ordinary skill in the art.

Further, the Examiner acknowledges in the Office Action that neither Holah et al. nor Cooke et al. teach that the pyridinylbenzamide compound can be combined with an additional compound (b) in a weight ratio from 0.01 to 20.

The Examiner argues that:

> Colby teaches a method for calculating the synergistic effect of herbicidal compositions, from which the optimal ratio for each component can be determined. From the teachings of Colby, one could derive at the optimal ratio of N-{2-[3-chloro-5-(trifluoromethyl)- 2-pyridinyl]ethyl}-2- trifluoromethylbenzamide to the additional fungicidal agents, to achieve the highest synergistic effect.

It is respectfully submitted that the Examiner's argument is untenable.

One factor that is very commonly used to show that a chemical invention involving the combination of two or more compounds is unobvious is to show that the whole is greater than the sum of its parts, i.e., that the two interact synergistically to yield a result that is greater than

that which could be achieved by either compound used alone. The present case is such an example and uses the Colby method to determine whether or not synergism is present. The Colby method is simply a means for showing mathematically that an invention is unobvious because of synergism after the invention has been made. The method is not used in the conception or reduction to practice of the invention itself. If the Examiner's position were to prevail, it is submitted that it would greatly hinder the progress of science and the useful art of chemistry.

Accordingly, it is requested that the rejection of claims 1, 2, and 4 through 17 under 35 U.S.C. § 103(a) as being unpatentable over Cooke et al. in view of Holah et al. and further in view of Colby be withdrawn.

Claims 1, 2, 4 through 9, 16, and 17 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4 through 9, 18, and 19 of U.S. Patent Application No. 10/587,802 in view of Leroux, 47 PEST. SCI., 191-97 (1996).

As pointed out in the Office Action, a timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application.

The present application and U.S. Patent Application No. 10/587,802 are commonly owned by Bayer CropScience S.A., 16 Jean-Marie Leclair, F-69009 Lyon, France.

A Terminal Disclaimer under 37 C.F.R. § 1.321(b) and (c) disclaiming, with the customary exceptions, the terminal part of the statutory term of any patent granted on the instant

application that would extend beyond the expiration date(s) of the full statutory term(s) of any patent(s) issued on U.S. Patent Application No. 10/587,802 is filed herewith.

Accordingly, it is requested that the provisional rejection of claims 1, 2, 4 through 9, 16, and 17 on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1, 2, 4 through 9, 18, and 19 of U.S. Patent Application No. 10/587,802 in view of Leroux be withdrawn.

In view of the foregoing, it is submitted that this application is in condition for allowance, and an early Office Action to that end is earnestly requested.

Respectfully submitted,

Paul Grandinetti
Registration No. 30,754
OSTROLENK, FABER, GERB & SOFFEN, LLP
1180 Avenue of the Americas
New York, New York 10036-8403
Telephone (212) 382-0700